



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,293	07/07/2006	Roland Kolb	SCH-16682	5013
40854 7590 01/05/2010 RANKIN, HILL, & CLARK LLP 38210 Glenn Avenue WILLOUGHBY, OH 44094-7808				
EXAMINER				
ROBTAILLE, JOHN P				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
01/05/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,293

Applicant(s)

KOLB ET AL.

Examiner

John P. Robitaille

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This action is a response to the mailing received 18 September 2009. Claims 1, 5-6, and 12 are pending.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 5, 6, & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 3,534,422 (Carpenter et al.) in view of U.S. Patent 6,523,251 (Meisser et al.) in view of U.S. Patent 2,202,580 (Louis F. Hahn, '580 hereafter) in view of United Kingdom Patent GB 1 546 159 to Gregory et al. (already of record).

3. Regarding claim 1, '422 teaches a method for manufacturing adjustment shafts comprising a metallic shaft and a noise-abating, non-metallic external cladding situated between cladding-free shaft ends, where, starting with a metallic shaft strand continuously fitted with said external cladding, said cladding is removed in the zone of the axially continuous shaft ends by at least one radially approachable brush (C1L25-C1L30). '422 does not teach pivoting, or severing the shaft.

4. In the same field of endeavor, the production of elongate partially insulated members, '251 teaches the external cladding is removed from continuous shaft ends (C1L5-C1L12) for the benefit of removing the insulating material in a continuous process, thereby improving the economic efficiency of the process. It would have been obvious to

a person of ordinary skill in the art at the time of invention to combine the teachings of '422 with those of '251 for the benefit of removing the insulation from the shaft in a continuous manner. The combination of '422 with '251 does not teach the subsequent severing to the shafts.

5. In the same field of endeavor, production of elongate members, '580 teaches the severing of shafts (C1L1-C1L5) for the benefit of preparing shafts of a desired length. It would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of the previous art combination with those of '580 for the benefit of preparing insulated shafts of a desired length.

6. In the same field of endeavor, shaft debrading, GB'159 teaches teaches the method wherein at least one externally and preferably radially approachable brush is pivoted tangentially about the metallic shaft strand in the sense of a progressive peripheral removal of external cladding from said strand (L85) for the benefit debrading the entire circumference of the member. It would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of the previous art combination with GB'159 for the benefit of removing the insulation from the entire circumference of the member.

7. Regarding claim 5, '422 teaches the method wherein the brush is approached in a manner that the radial length of its bristles operationally extends maximally as far as the peripheral surface of the bared shaft ends (C2L60-C2L65).

8. Regarding claim 6, the combination of '422 with '251 does not teach that the shaft ends are fitted with a square torque transmitting connector.

9. In the same field of endeavor, production of elongate members, '580 teaches the method wherein the shaft strand is fitted in the region of the bared shaft ends with a geometrically interlocking torque transmitting connector of which an outer contour deviates from the circular form and is in particular square (Pg 3 Ls 1-5) for the benefit of imparting torque to the shafts. It would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of the previous art combination and '580 for the benefit of imparting torque to the finished partially insulated shafts.
10. Regarding claim 12, '422 teaches the method wherein at least one brush is approached radially (FIG 1 – item C).

Response to Arguments

11. Applicant has advanced two arguments in support of the patentability of the instant application. They are:
- a. '422 does not teach a circumferentially pivoting a brush about the member.
 - b. '251 teaches away from the combination.
12. The first argument, has been fully considered and is persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of GB 1 546 159 to Gregory et al.
13. Regarding the second argument, the examiner is not persuaded that '251 teaches away from the claimed invention. '251 teaches insulation removal prior to continuity testing and the instant invention removes insulation prior to the severing of the shafts. Since the claimed invention requires severing subsequent to insulation

removal, '251's solution would commend itself to the ordinary artisan since the step of continuity testing would ensure that the shaft is not damaged in the insulation removal step.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Robitaille whose telephone number is (571) 270-7006. The examiner can normally be reached on Monday to Thursday from 8:00 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Del Sole can be reached on (571) 272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JPR

/Joseph S. Del Sole/
Supervisory Patent Examiner, Art Unit 1791